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REMARKS

Applicant respectfully requests entry of the following amendments and remarks in response to the Advisory Action mailed April 3, 2009. Applicant submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 4, 6 – 11, 13 – 19, 21 – 27, and 30 are pending. In particular, Applicant adds claim 30, amends claims 1, 9, 14 – 16, and 23 – 25. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Rejections Under 35 U.S.C. §103

A. Claim 1 is Allowable Over *Couts* in view of *Morris*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 ("*Couts*") in view of U.S. Patent Number 6,496,851 ("*Morris*"). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A communication system comprising:
receive logic configured to receive an instant messaging (IM) message from a first user to a second user;
first prompting logic configured to prompt the first user for permission to convey the IM message to a third user;
determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user;
indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user,
second prompting logic configured to prompt the first user to join the IM chat session;
third prompting logic configured to, in response to receiving an indication that the first user wants to join the IM chat session, prompting the second user and the fourth user to allow

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the first user to join the IM chat session; and
joining logic configured to, in response to receiving an indication that the second user and the fourth user want to allow the first user to join the IM chat session, facilitating joining of the first user to the IM chat session.

(Emphasis added).

Applicant respectfully submits that claim 1, as amended, is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a "communication method comprising... *indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user*" as recited in claim 1. More specifically, the Advisory Action (which simply reiterates rejections from the Final Office Action) argues:

Couts in paragraph [0027], discloses the determination of the device or client status and taking further step after determination of device or client status and further explanation is given in paragraphs [0041-0047] that how response is given to originating device about the availability, status and forwarding lists of the target device...

(FOA page 2, line 12).

Applicant respectfully disagrees. More specifically, *Couts* discloses "if the target device is unavailable, then the messaging proxy 120 determines whether the originating device allows forwarding of the messages" (page 4, paragraph [0028]). Additionally, *Couts* discloses "the messaging server and/or messaging proxy may also block or obscure user identities as well. In the example above, it is possible for Users A and B to exchange messages without knowing each other's identities since all messages may be directed to User D" (page 5, paragraph [0047]). Further, *Couts* discloses that, if a user is unavailable, the sender is not notified of anything. In fact, *Couts* discloses blocking users from knowing the identity of the user to whom the communication was routed. Consequently, not only does *Couts* fail to suggest "*indicating to the first user, in response to determining that the second user is engaged in an IM*

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chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user as recited in claim 1, but teaches away from this element.

Similarly, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Final Office Action argues:

Morris discloses, indicating to the first user (*Morris*, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (*Morris*, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

(OA page 2, line 15).

Applicant respectfully disagrees. As illustrated in this passage, the Office Action is inferring that *Morris* could have disclosed a fourth user and that displaying that a proposal was rejected could include indicating that the second user is engaged in an IM session with the fourth user. This argument presented by the Office Action clearly has no basis. Nowhere does *Morris* even suggest that either of these elements could occur. In fact, there is no "fourth user" even suggested by *Morris*. Additionally, as illustrated in FIG. 13, *Morris* merely indicates that a chat invitation was denied. Further, with regard to FIG. 13, *Morris* states "[t]he only option available to the proposal originator is to click the 'OK' option" (column 12, line 42). Not only does *Morris* fail to disclose "*indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user*" as recited in claim 1, but *Morris* does not even suggest an embodiment where "*indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user*" could be included.

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Additionally, the Advisory Action argues "[f]urther, As (sic) for [the] argument for motivation to combine, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (AA continuation sheet, line 7). Applicant submits that this statement is a clear indication of the level of consideration the present application has received. More specifically, Applicant has never made a motivation to combine argument. However, in view of KSR, in order to establish an obviousness rejection with multiple references, there must be some reason (either explicit or implicit) to make the combination. Further, such analysis of whether there is motivation, should be made explicit, which the Office Action has failed to perform. Additionally, mere conclusory statements of motivation are not sufficient.

However, while Applicant continues to traverse these rejections, Applicant amends claim 1 to more clearly recite ***"Joining logic configured to, in response to receiving an indication that the second user and the fourth user want to allow the first user to joint the IM chat session, facilitating joining of the first user to the IM chat session."*** Applicant submits that neither *Couts* nor *Morris*, taken alone or in combination discloses or suggests this element. For at least these reasons, claim 1 is allowable.

B. Claim 9 is Allowable Over Couts in view of Morris

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 ("*Couts*") in view of U.S. Patent Number 6,496,851 ("*Morris*"). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claim 9. More specifically, claim 9 recites:

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A communication method comprising:
receiving an instant messaging (IM) message from a first user to a second user;
conveying the IM message to a third user;
determining whether the second user is currently engaged in an IM chat session with a fourth user;

indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user,

prompting the first user to join the IM chat session;
in response to receiving an indication that the first user wants to join the IM chat session, prompting the second user and the fourth user to allow the first user to join the IM chat session;
and

in response to receiving an indication that the second user and the fourth user want to allow the first user to join the IM chat session, facilitating joining of the first user to the IM chat session.

(Emphasis added).

Applicant respectfully submits that claim 9 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “communication method comprising... ***indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 9. More specifically, the Advisory Action (which simply reiterates rejections from the Final Office Action) argues:

Couts in paragraph [0027], discloses the determination of the device or client status and taking further step after determination of device or client status and further explanation is given in paragraphs [0041-0047] that how response is given to originating device about the availability, status and forwarding lists of the target device...

(FOA page 2, line 12).

Applicant respectfully disagrees. More specifically, *Couts* discloses “if the target device is unavailable, then the messaging proxy 120 determines whether the originating device allows forwarding of the messages” (page 4, paragraph [0028]). Additionally, *Couts* discloses “the

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messaging server and/or messaging proxy may also block or obscure user identities as well. In the example above, it is possible for Users A and B to exchange messages without knowing each other's identities since all messages may be directed to User D" (page 5, paragraph [0047]). Further, *Couts* discloses that, if a user is unavailable, the sender is not notified of anything. In fact, *Couts* discloses blocking users from knowing the identity of the user to whom the communication was routed. Consequently, not only does *Couts* fail to suggest ***"indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"*** as recited in claim 9, but teaches away from this element.

Similarly, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Final Office Action argues:

Morris discloses, indicating to the first user (Morris, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

(OA page 2, line 15).

Applicant respectfully disagrees. As illustrated in this passage, the Office Action is inferring that *Morris* could have disclosed a fourth user and that displaying that a proposal was rejected could include indicating that the second user is engaged in an IM session with the fourth user. This argument presented by the Office Action clearly has no basis. Nowhere does *Morris* even suggest that either of these elements could occur. In fact, there is no "fourth user" even suggested by *Morris*. Additionally, as illustrated in FIG. 13, *Morris* merely indicates that a chat invitation was denied. Further, with regard to FIG. 13, *Morris* states "[t]he only option available to the proposal originator is to click the 'OK' option" (column 12, line 42). Not only

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does *Morris* fail to disclose ***"indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"*** as recited in claim 9, but *Morris* does not even suggest an embodiment where ***"indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"*** could be included.

Additionally, the Advisory Action argues "[f]urther, As (sic) for [the] argument for motivation to combine, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (AA continuation sheet, line 7). Applicant submits that this statement is a clear indication of the level of consideration the present application has received. More specifically, Applicant has never made a motivation to combine argument. However, in view of KSR, in order to establish an obviousness rejection with multiple references, there must be some reason (either explicit or implicit) to make the combination. Further, such analysis of whether there is motivation, should be made explicit, which the Office Action has failed to perform. Additionally, mere conclusory statements of motivation are not sufficient.

However, while Applicant continues to traverse these rejections, Applicant amends claim 9 to more clearly recite ***"in response to receiving an indication that the second user and the fourth user want to allow the first user to join the IM chat session, facilitating joining of the first user to the IM chat session."*** Applicant submits that neither *Couts* nor *Morris*, taken alone or in combination discloses or suggests this element. For at least these reasons, claim 9 is allowable.

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C. Claim 14 is Allowable Over *Couts* in view of *Morris*

The Office Action indicates that claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 ("*Couts*") in view of U.S. Patent Number 6,496,851 ("*Morris*"). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claim 14. More specifically, claim 14 recites:

A communication system comprising:
receive logic configured to receive an instant messaging (IM) message from a first user to a second user;
first prompting logic configured to prompt the first user for permission to convey the IM message to a third user;
determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user;
indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user,
second prompting logic configured to prompt the first user to join the IM chat session;
third prompting logic configured to, in response to receiving an indication that the first user wants to join the IM chat session, prompting the second user and the fourth user to allow the first user to join the IM chat session; and
joining logic configured to, in response to receiving an indication that the second user and the fourth user want to allow the first user to join the IM chat session, facilitating joining of the first user to the IM chat session.

(Emphasis added).

Applicant respectfully submits that claim 14 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a "communication system comprising... ***indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***" as recited in claim 14. More specifically, the Advisory Action (which simply reiterates rejections from the Final Office Action) argues:

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Couts in paragraph [0027], discloses the determination of the device or client status and taking further step after determination of device or client status and further explanation is given in paragraphs [0041-0047] that how response is given to originating device about the availability, status and forwarding lists of the target device...

(FOA page 2, line 12).

Applicant respectfully disagrees. More specifically, *Couts* discloses "if the target device is unavailable, then the messaging proxy 120 determines whether the originating device allows forwarding of the messages" (page 4, paragraph [0028]). Additionally, *Couts* discloses "the messaging server and/or messaging proxy may also block or obscure user identities as well. In the example above, it is possible for Users A and B to exchange messages without knowing each other's identities since all messages may be directed to User D" (page 5, paragraph [0047]). Further, *Couts* discloses that, if a user is unavailable, the sender is not notified of anything. In fact, *Couts* discloses blocking users from knowing the identity of the user to whom the communication was routed. Consequently, not only does *Couts* fail to suggest **"indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"** as recited in claim 14, but teaches away from this element.

Similarly, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Final Office Action argues:

Morris discloses, indicating to the first user (Morris, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

(OA page 2, line 15).

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Applicant respectfully disagrees. As illustrated in this passage, the Office Action is inferring that Morris could have disclosed a fourth user and that displaying that a proposal was rejected could include indicating that the second user is engaged in an IM session with the fourth user. This argument presented by the Office Action clearly has no basis. Nowhere does Morris even suggest that either of these elements could occur. In fact, there is no "fourth user" even suggested by Morris. Additionally, as illustrated in FIG. 13, Morris merely indicates that a chat invitation was denied. Further, with regard to FIG. 13, Morris states "[t]he only option available to the proposal originator is to click the 'OK' option" (column 12, line 42). Not only does Morris fail to disclose **"indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"** as recited in claim 14, but Morris does not even suggest an embodiment where **"indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"** could be included.

Additionally, the Advisory Action argues "[f]urther, As (sic) for [the] argument for motivation to combine, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (AA continuation sheet, line 7). Applicant submits that this statement is a clear indication of the level of consideration the present application has received. More specifically, Applicant has never made a motivation to combine argument. However, in view of KSR, in order to establish an obviousness rejection with multiple references, there must be some reason (either explicit or implicit) to make the combination. Further, such analysis of whether there is motivation, should be made explicit, which the Office Action has failed to perform. Additionally, mere conclusory statements of motivation are not sufficient.

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However, while Applicant continues to traverse these rejections, Applicant amends claim 14 to more clearly recite ***“joining logic configured to, in response to receiving an indication that the second user and the fourth user want to allow the first user to joint the IM chat session, facilitating joining of the first user to the IM chat session.”*** Applicant submits that neither *Couts* nor *Morris*, taken alone or in combination discloses or suggests this element. For at least these reasons, claim 14 is allowable.

D. Claim 15 is Allowable Over *Couts* in view of *Morris*

The Office Action indicates that claim 15 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 (“*Couts*”) in view of U.S. Patent Number 6,496,851 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claim 15. More specifically, claim 15 recites:

A communication system comprising:
means for receiving an instant messaging (IM) message from a first user to a second user;
means for prompting the first user for permission to convey the IM message to a third user;
means for determining whether the second user is currently engaged in an IM chat session with a fourth user;
means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user;
means for prompting the first user to join the IM chat session;
means for, in response to receiving an indication that the first user wants to join the IM chat session, prompting the second user and the fourth user to allow the first user to join the IM chat session; and
means for, in response to receiving an indication that the second user and the fourth user want to allow the first user to joint the IM chat session, facilitating joining of the first user to the IM chat session.

(Emphasis added).

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Applicant respectfully submits that claim 15 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a "communication system comprising... ***means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***" as recited in claim 15. More specifically, the Advisory Action (which simply reiterates rejections from the Final Office Action) argues:

Couts in paragraph [0027], discloses the determination of the device or client status and taking further step after determination of device or client status and further explanation is given in paragraphs [0041-0047] that how response is given to originating device about the availability, status and forwarding lists of the target device...
(FOA page 2, line 12).

Applicant respectfully disagrees. More specifically, *Couts* discloses "if the target device is unavailable, then the messaging proxy 120 determines whether the originating device allows forwarding of the messages" (page 4, paragraph [0028]). Additionally, *Couts* discloses "the messaging server and/or messaging proxy may also block or obscure user identities as well. In the example above, it is possible for Users A and B to exchange messages without knowing each other's identities since all messages may be directed to User D" (page 5, paragraph [0047]). Further, *Couts* discloses that, if a user is unavailable, the sender is not notified of anything. In fact, *Couts* discloses blocking users from knowing the identity of the user to whom the communication was routed. Consequently, not only does *Couts* fail to suggest "***means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***" as recited in claim 15, but teaches away from this element.

Similarly, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Final Office Action argues:

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Morris discloses, indicating to the first user (Morris, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

(OA page 2, line 15).

Applicant respectfully disagrees. As illustrated in this passage, the Office Action is inferring that Morris could have disclosed a fourth user and that displaying that a proposal was rejected could include indicating that the second user is engaged in an IM session with the fourth user. This argument presented by the Office Action clearly has no basis. Nowhere does Morris even suggest that either of these elements could occur. In fact, there is no "fourth user" even suggested by Morris. Additionally, as illustrated in FIG. 13, Morris merely indicates that a chat invitation was denied. Further, with regard to FIG. 13, Morris states "[t]he only option available to the proposal originator is to click the 'OK' option" (column 12, line 42). Not only does Morris fail to disclose "**means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user**" as recited in claim 15, but Morris does not even suggest an embodiment where "**means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user**" could be included.

Additionally, the Advisory Action argues "[f]urther, As (sic) for [the] argument for motivation to combine, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (AA continuation sheet, line 7). Applicant submits that this statement is a clear indication of the level of consideration the

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present application has received. More specifically, Applicant has never made a motivation to combine argument. However, in view of KSR, in order to establish an obviousness rejection with multiple references, there must be some reason (either explicit or implicit) to make the combination. Further, such analysis of whether there is motivation, should be made explicit, which the Office Action has failed to perform. Additionally, mere conclusory statements of motivation are not sufficient.

However, while Applicant continues to traverse these rejections, Applicant amends claim 15 to more clearly recite "*means for, in response to receiving an indication that the second user and the fourth user want to allow the first user to joint the IM chat session, facilitating joining of the first user to the IM chat session.*" Applicant submits that neither *Couts* nor *Morris*, taken alone or in combination discloses or suggests this element. For at least these reasons, claim 15 is allowable.

E. Claim 16 is Allowable Over *Couts* in view of *Morris*

The Office Action indicates that claim 16 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 ("*Couts*") in view of U.S. Patent Number 6,496,851 ("*Morris*"). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claim 16. More specifically, claim 16 recites:

A computer-readable medium that stores a program that, when executed by a computer, causes the computer to perform at least the following:

receive an instant messaging (IM) message from a first user to a second user;

prompt the first user for permission to convey the IM message to a third user;

determine whether the second user is currently engaged in an IM chat session with a fourth user; and

indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a

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fourth user, that the second user is engaged in an IM chat session with the fourth user,

prompt the first user to join the IM chat session;
in response to receiving an indication that the first user wants to join the IM chat session, prompt the second user and the fourth user to allow the first user to join the IM chat session; and
in response to receiving an indication that the second user and the fourth user want to allow the first user to join the IM chat session, facilitate joining of the first user to the IM chat session.

(Emphasis added).

Applicant respectfully submits that claim 16 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “computer-readable medium that stores a program that, when executed by a computer, causes the computer to perform at least the following... ***indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 16. More specifically, the Advisory Action (which simply reiterates rejections from the Final Office Action) argues:

Couts in paragraph [0027], discloses the determination of the device or client status and taking further step after determination of device or client status and further explanation is given in paragraphs [0041-0047] that how response is given to originating device about the availability, status and forwarding lists of the target device...

(FOA page 2, line 12).

Applicant respectfully disagrees. More specifically, *Couts* discloses “if the target device is unavailable, then the messaging proxy 120 determines whether the originating device allows forwarding of the messages” (page 4, paragraph [0028]). Additionally, *Couts* discloses “the messaging server and/or messaging proxy may also block or obscure user identities as well. In the example above, it is possible for Users A and B to exchange messages without knowing each other’s identities since all messages may be directed to User D” (page 5, paragraph [0047]). Further, *Couts* discloses that, if a user is unavailable, the sender is not notified of

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anything. In fact, *Couts* discloses blocking users from knowing the identity of the user to whom the communication was routed. Consequently, not only does *Couts* fail to suggest ***"indicat[ing] to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"*** as recited in claim 16, but teaches away from this element.

Similarly, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Final Office Action argues:

Morris discloses, indicating to the first user (Morris, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

(OA page 2, line 15).

Applicant respectfully disagrees. As illustrated in this passage, the Office Action is inferring that *Morris* could have disclosed a fourth user and that displaying that a proposal was rejected could include indicating that the second user is engaged in an IM session with the fourth user. This argument presented by the Office Action clearly has no basis. Nowhere does *Morris* even suggest that either of these elements could occur. In fact, there is no "fourth user" even suggested by *Morris*. Additionally, as illustrated in FIG. 13, *Morris* merely indicates that a chat invitation was denied. Further, with regard to FIG. 13, *Morris* states "[t]he only option available to the proposal originator is to click the 'OK' option" (column 12, line 42). Not only does *Morris* fail to disclose ***"indicat[ing] to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"*** as recited in claim 16, but *Morris* does not even suggest an embodiment where ***"indicat[ing] to the first user, in response to***

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determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user" could be included.

Additionally, the Advisory Action argues "[f]urther, As (sic) for [the] argument for motivation to combine, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (AA continuation sheet, line 7). Applicant submits that this statement is a clear indication of the level of consideration the present application has received. More specifically, Applicant has never made a motivation to combine argument. However, in view of KSR, in order to establish an obviousness rejection with multiple references, there must be some reason (either explicit or implicit) to make the combination. Further, such analysis of whether there is motivation, should be made explicit, which the Office Action has failed to perform. Additionally, mere conclusory statements of motivation are not sufficient.

However, while Applicant continues to traverse these rejections, Applicant amends claim 16 to more clearly recite ***"in response to receiving an indication that the second user and the fourth user want to allow the first user to joint the IM chat session, facilitate joining of the first user to the IM chat session."*** Applicant submits that neither *Couts* nor *Morris*, taken alone or in combination discloses or suggests this element. For at least these reasons, claim 16 is allowable.

F. Claim 23 is Allowable Over Couts in view of Morris

The Office Action indicates that claim 23 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 ("*Couts*") in view of U.S. Patent Number 6,496,851 ("*Morris*"). Applicant respectfully traverses this rejection

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for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claim 23. More specifically, claim 23 recites:

A communication system comprising:
receive logic configured to receive an instant messaging (IM) message from a first user to a second user;
conveying logic configured to convey the IM message to a third user;
determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user;
indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user,
first prompting logic configured to prompt the first user to join the IM chat session;
second prompting logic configured to, in response to receiving an indication that the first user wants to join the IM chat session, prompt the second user and the fourth user to allow the first user to join the IM chat session; and
joining logic configured to, in response to receiving an indication that the second user and the fourth user want to allow the first user to join the IM chat session, facilitate joining of the first user to the IM chat session.

(Emphasis added).

Applicant respectfully submits that claim 23 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a "communication system comprising... ***Indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***" as recited in claim 23. More specifically, the Advisory Action (which simply reiterates rejections from the Final Office Action) argues:

Couts in paragraph [0027], discloses the determination of the device or client status and taking further step after determination of device or client status and further explanation is given in paragraphs [0041-0047] that how response is given to originating device about the availability, status and forwarding lists of the target device...

(FOA page 2, line 12).

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Applicant respectfully disagrees. More specifically, *Couts* discloses "if the target device is unavailable, then the messaging proxy 120 determines whether the originating device allows forwarding of the messages" (page 4, paragraph [0028]). Additionally, *Couts* discloses "the messaging server and/or messaging proxy may also block or obscure user identities as well. In the example above, it is possible for Users A and B to exchange messages without knowing each other's identities since all messages may be directed to User D" (page 5, paragraph [0047]). Further, *Couts* discloses that, if a user is unavailable, the sender is not notified of anything. In fact, *Couts* discloses blocking users from knowing the identity of the user to whom the communication was routed. Consequently, not only does *Couts* fail to suggest ***"indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"*** as recited in claim 23, but teaches away from this element.

Similarly, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Final Office Action argues:

Morris discloses, indicating to the first user (Morris, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

(OA page 2, line 15).

Applicant respectfully disagrees. As illustrated in this passage, the Office Action is inferring that *Morris* could have disclosed a fourth user and that displaying that a proposal was rejected could include indicating that the second user is engaged in an IM session with the fourth user. This argument presented by the Office Action clearly has no basis. Nowhere does

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Morris even suggest that either of these elements could occur. In fact, there is no "fourth user" even suggested by *Morris*. Additionally, as illustrated in FIG. 13, *Morris* merely indicates that a chat invitation was denied. Further, with regard to FIG. 13, *Morris* states "[t]he only option available to the proposal originator is to click the 'OK' option" (column 12, line 42). Not only does *Morris* fail to disclose **"indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"** as recited in claim 23, but *Morris* does not even suggest an embodiment where **"indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"** could be included.

Additionally, the Advisory Action argues "[f]urther, As (sic) for [the] argument for motivation to combine, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (AA continuation sheet, line 7). Applicant submits that this statement is a clear indication of the level of consideration the present application has received. More specifically, Applicant has never made a motivation to combine argument. However, in view of KSR, in order to establish an obviousness rejection with multiple references, there must be some reason (either explicit or implicit) to make the combination. Further, such analysis of whether there is motivation, should be made explicit, which the Office Action has failed to perform. Additionally, mere conclusory statements of motivation are not sufficient.

However, while Applicant continues to traverse these rejections, Applicant amends claim 23 to more clearly recite **"joining logic configured to, in response to receiving an indication that the second user and the fourth user want to allow the first user to joint the IM chat session, facilitate joining of the first user to the IM chat session."** Applicant submits that

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neither *Couts* nor *Morris*, taken alone or in combination discloses or suggests this element. For at least these reasons, claim 23 is allowable.

G. Claim 24 is Allowable Over *Couts* in view of *Morris*

The Office Action indicates that claim 24 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 ("*Couts*") in view of U.S. Patent Number 6,496,851 ("*Morris*"). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claim 24. More specifically, claim 24 recites:

A communication system comprising:
means for receiving an instant messaging (IM) message from a first user to a second user;
means for conveying the IM message to a third user;
means for determining whether the second user is currently engaged in an IM chat session with a fourth user;
means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user,
means for prompting the first user to join the IM chat session;
means for, in response to receiving an indication that the first user wants to join the IM chat session, prompting the second user and the fourth user to allow the first user to join the IM chat session; and
means for, in response to receiving an indication that the second user and the fourth user want to allow the first user to join the IM chat session, facilitating joining of the first user to the IM chat session.

(Emphasis added).

Applicant respectfully submits that claim 24 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a "communication system comprising... ***means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***"

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as recited in claim 24. More specifically, the Advisory Action (which simply reiterates rejections from the Final Office Action) argues:

Couts in paragraph [0027], discloses the determination of the device or client status and taking further step after determination of device or client status and further explanation is given in paragraphs [0041-0047] that how response is given to originating device about the availability, status and forwarding lists of the target device...
(FOA page 2, line 12).

Applicant respectfully disagrees. More specifically, *Couts* discloses "if the target device is unavailable, then the messaging proxy 120 determines whether the originating device allows forwarding of the messages" (page 4, paragraph [0028]). Additionally, *Couts* discloses "the messaging server and/or messaging proxy may also block or obscure user identities as well. In the example above, it is possible for Users A and B to exchange messages without knowing each other's identities since all messages may be directed to User D" (page 5, paragraph [0047]). Further, *Couts* discloses that, if a user is unavailable, the sender is not notified of anything. In fact, *Couts* discloses blocking users from knowing the identity of the user to whom the communication was routed. Consequently, not only does *Couts* fail to suggest "***means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***" as recited in claim 24, but teaches away from this element.

Similarly, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Final Office Action argues:

Morris discloses, indicating to the first user (Morris, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and

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invitation can be due to various reasons e.g. busy, offline or not interested in proposal).
(OA page 2, line 15).

Applicant respectfully disagrees. As illustrated in this passage, the Office Action is *inferring* that *Morris could have disclosed* a fourth user and that displaying that a proposal was rejected *could include* indicating that the second user is engaged in an IM session with the fourth user. This argument presented by the Office Action clearly has no basis. Nowhere does *Morris* even suggest that either of these elements could occur. In fact, there is no "fourth user" even suggested by *Morris*. Additionally, as illustrated in FIG. 13, *Morris* merely indicates that a chat invitation was denied. Further, with regard to FIG. 13, *Morris* states "[t]he only option available to the proposal originator is to click the 'OK' option" (column 12, line 42). Not only does *Morris* fail to disclose ***"means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"*** as recited in claim 24, but *Morris* does not even suggest an embodiment where ***"means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user"*** could be included.

Additionally, the Advisory Action argues "[f]urther, As (sic) for [the] argument for motivation to combine, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (AA continuation sheet, line 7). Applicant submits that this statement is a clear indication of the level of consideration the present application has received. More specifically, Applicant has never made a motivation to combine argument. However, in view of KSR, in order to establish an obviousness rejection with multiple references, there must be some reason (either explicit or implicit) to make the combination. Further, such analysis of whether there is motivation, should be made explicit,

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which the Office Action has failed to perform. Additionally, mere conclusory statements of motivation are not sufficient.

However, while Applicant continues to traverse these rejections, Applicant amends claim 24 to more clearly recite ***"means for, in response to receiving an indication that the second user and the fourth user want to allow the first user to joint the IM chat session, facilitating joining of the first user to the IM chat session."*** Applicant submits that neither *Couts* nor *Morris*, taken alone or in combination discloses or suggests this element. For at least these reasons, claim 24 is allowable.

H. Claim 25 is Allowable Over *Couts* in view of *Morris*

The Office Action indicates that claim 25 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 ("*Couts*") in view of U.S. Patent Number 6,496,851 ("*Morris*"). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claim 25. More specifically, claim 25 recites:

A computer-readable medium that includes a computer program that, when executed by a computer, causes the computer to perform at least the following:

receive an instant messaging (IM) message from a first user to a second user;

convey the IM message to a third user;

determine whether the second user is currently engaged in an IM chat session with a fourth user; and

indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user;

prompt the first user to join the IM chat session;

in response to receiving an indication that the first user wants to join the IM chat session, prompt the second user to allow the first user to join the IM chat session; and

in response to receiving an indication that the second user wants to allow the first user to joint the IM chat session, facilitate joining of the first user to the IM chat session.

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(Emphasis added).

Applicant respectfully submits that claim 25 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a "computer-readable medium that includes a computer program that, when executed by a computer, causes the computer to perform at least the following... ***indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***" as recited in claim 25. More specifically, the Advisory Action (which simply reiterates rejections from the Final Office Action) argues:

Couts in paragraph [0027], discloses the determination of the device or client status and taking further step after determination of device or client status and further explanation is given in paragraphs [0041-0047] that how response is given to originating device about the availability, status and forwarding lists of the target device...

(FOA page 2, line 12).

Applicant respectfully disagrees. More specifically, *Couts* discloses "if the target device is unavailable, then the messaging proxy 120 determines whether the originating device allows forwarding of the messages" (page 4, paragraph [0028]). Additionally, *Couts* discloses "the messaging server and/or messaging proxy may also block or obscure user identities as well. In the example above, it is possible for Users A and B to exchange messages without knowing each other's identities since all messages may be directed to User D" (page 5, paragraph [0047]). Further, *Couts* discloses that, if a user is unavailable, the sender is not notified of anything. In fact, *Couts* discloses blocking users from knowing the identity of the user to whom the communication was routed. Consequently, not only does *Couts* fail to suggest ***"Indicate[ing] to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an***

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IM chat session with the fourth user as recited in claim 25, but teaches away from this element.

Similarly, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Final Office Action argues:

Morris discloses, indicating to the first user (Morris, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

(OA page 2, line 15).

Applicant respectfully disagrees. As illustrated in this passage, the Office Action is inferring that *Morris* could have disclosed a fourth user and that displaying that a proposal was rejected could include indicating that the second user is engaged in an IM session with the fourth user. This argument presented by the Office Action clearly has no basis. Nowhere does *Morris* even suggest that either of these elements could occur. In fact, there is no "fourth user" even suggested by *Morris*. Additionally, as illustrated in FIG. 13, *Morris* merely indicates that a chat invitation was denied. Further, with regard to FIG. 13, *Morris* states "[t]he only option available to the proposal originator is to click the 'OK' option" (column 12, line 42). Not only does *Morris* fail to disclose "*Indicate[ing] to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user*" as recited in claim 25, but *Morris* does not even suggest an embodiment where "*indicate[ing] to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user*" could be included.

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Additionally, the Advisory Action argues "[f]urther, As (sic) for [the] argument for motivation to combine, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (AA continuation sheet, line 7). Applicant submits that this statement is a clear indication of the level of consideration the present application has received. More specifically, Applicant has never made a motivation to combine argument. However, in view of KSR, in order to establish an obviousness rejection with multiple references, there must be some reason (either explicit or implicit) to make the combination. Further, such analysis of whether there is motivation, should be made explicit, which the Office Action has failed to perform. Additionally, mere conclusory statements of motivation are not sufficient.

However, while Applicant continues to traverse these rejections, Applicant amends claim 25 to more clearly recite *"In response to receiving an indication that the second user wants to allow the first user to joint the IM chat session, facilitate joining of the first user to the IM chat session."* Applicant submits that neither *Couts* nor *Morris*, taken alone or in combination discloses or suggests this element. For at least these reasons, claim 25 is allowable.

I. Claims 2 – 4, 6 – 8, 10 – 11, 13, 17 – 19, 21 – 22, 26 – 27, and 29 are Allowable Over *Couts* in view of *Morris*

The Office Action indicates that claims 2 – 4, 6 – 8, 10 – 11, 13, 17 – 19, 21 – 22, 26 – 27, and 29 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication Number 2003/0120805 ("*Couts*") in view of U.S. Patent Number 6,496,851 ("*Morris*"). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 2 – 4, 6 – 8, 10 – 11, 13, 17 – 19, 21 – 22, 26 – 27, and 29. More specifically, dependent claims 2 – 4 and 6 – 8

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are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claims 10 – 11 and 13 are allowable for at least the reason that they depend from and include the elements of allowable independent claim 9. Dependent claims 17 – 19 and 21 – 22 are allowable for at least the reason that they depend from and include the elements of allowable independent claim 16. Dependent claims 26 – 27 and 29 are allowable for at least the reason that they depend from and include the elements of allowable independent claim 25. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

II. New Claim 30 is Allowable

In addition, Applicant adds new claim 30. New claim 30 is allowable for at least the reason that this claim depends from allowable independent claim 25. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

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